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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CFC0001

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Application Number

Filed

10/805,935

3/22/04

First Named Inventor

C. COHEN

Art Unit

3727

Examiner

R. HOESLY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number

40,361

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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8/9/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Cheryl F. Cohen

Serial No.: 10/805,935

Art Unit: 3727

Confirmation No.: 1026

Filed: March 22, 2004

Examiner: Ryan C. Hoesly

For: THEFT DETERRENT BACKPACK

**REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST**

Mail Stop AF
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This communication is being filed in response to the Final Office Action mailed May 20, 2005. Simultaneously filed herewith is a Notice of Appeal pursuant to 37 CFR 41.31 and A Pre-Appeal Brief Request for Review (PTO/SB/33).

Claims 1-9, 11-19 and 21-24 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,154,332 (Williams). Claims 1-24 are rejected under 35 U.S.C. §103(a) as obvious over Williams.

The preamble of each claim is directed to "a backpack" while the body of the claims specify the elements or features of the backpack. Applicant submits that the term "backpack" in the preamble of each claim must be accorded patentable weight. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the

claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The Federal Circuit in the case *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994) was asked to determine whether the term "computer" in the claim preamble (e.g., "A portable computer..., said computer comprising") was properly rejected by the Patent Office as anticipated by a reference that disclosed all the claim's limitations in a calculator. The Court held that the term "computer" was one that breathes life and meaning into the claims and hence is a necessary limitation to them.

The same principles established in the case *In re Paulsen* applies in the present application in which the term "backpack" breathes life and meaning into the claims and thus is a necessary limitation to them. Every enclosure having panels and a main compartment is not a "backpack". Therefore, in order to read on the present claimed invention a reference must disclose the claimed limitations comprising part of a backpack.

In rejecting the present claimed backpack invention the Examiner improperly refers to the fabric enclosure 16 and the features associated therewith (e.g., front panel 26, back panel 28, two side panels 34a, 34b, top panel 32, bottom panel 30, main compartment 16, zipper 14c) (see May 20, 2005 Final Office Action: p. 2) while ignoring the backpack limitation. The fabric enclosure 16 is a shielding encasement separate from and not a part of the backpack 58 (Fig. 4). Williams fails to disclose backpack 58 having the claimed limitations, i.e., a releasable securing device/zipper chain for accessing the main compartment, wherein the terminating end is disposed on the back panel and the beginning end is disposed on the second panel, as in claims 1 and 12.

Furthermore, dependent claims 9 and 19 require the releasable securing device "to be disposed substantially laterally, when the backpack is held substantially upright". The Examiner maintains that "The top panel of the Williams device could be considered the bottom or side panel depending on the orientation of the device. For example, in Figures 7 and 8 disclosed by Williams, it is shown that the releasable securing devices and panels of the enclosure can take a variety of orientations while remaining within the scope and spirit of the disclosure." (May 20, 2005 Final Office Action: p. 2) Figs. 7 & 8 disclose a cylindrical shaped fabric enclosure 16 and a longitudinal V arrangement of

the zippers, respectively, with the zippers oriented in a longitudinal direction. Neither embodiment shows backpack 58 with the zippers oriented in a substantially lateral orientation when disposed in an upright position, as found in claims 9 and 19.

Applicant also disagrees with the Examiner that “the top panel of the Williams device could be considered the bottom or side panel depending on the orientation of the device”. The orientation of the fabric enclosure 16 and backpack 58 must be the same to ensure that one fits over the other and to allow the shoulder straps 52 to pass entirely through the opening of the fabric enclosure 16. Since the claim calls for the backpack to be in a substantially upright position, fabric enclosure 16 must be oriented either as shown in the Figures or rotated by 180 degrees in a vertical direction, with the zippers oriented substantially longitudinally (not substantially laterally, as claimed).

The Examiner also asserts that “Williams further discloses, ‘a closure device could be configured in a T orientation’ (Col. 5, l. 22) which would position a releasable securing device laterally where it would extend across a portion of the side panel.” However, the reference fails to disclose or suggest that the lateral section of the T would extend beyond the back panel and thus fails to read on the limitation provided in the base claim that calls for the releasable securing device having a terminating end disposed on the back panel and a beginning end disposed on a second panel. Without such teaching the reference fails to anticipate the claimed invention calling for the releasable securing device to have a terminating end disposed on the back panel, a beginning end disposed on a second panel, and the releasable securing device being disposed substantially laterally when the backpack is held substantially upright.

Yet another conclusion drawn by the Examiner is that “a second set of straps (18) are disposed laterally, which, when carried in this orientation, would cause the releasable securing device to extend across at least a portion of the side panel.” Handle straps 18 in Williams are not analogous to the claimed releasable securing device “for accessing the main compartment” of the backpack 58 (as called for in the base claim), but instead the handle straps 18 when released allow passage into the interior of the fabric enclosure 16.

Dependent claim 19 is further distinguishable over Williams in that it expressly calls for “the zipper chain” to be “disposed substantially laterally, when the backpack is

held substantially upright". Applicant asserts that contrary to the Examiner's statements, handle straps 18 of Williams are not analogous to the claimed zipper chain.

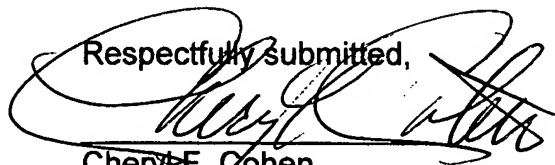
Dependent claims 11 and 21 are further distinguishable over Williams in that each calls for the releasable securing device/zipper chain to be "adapted to extend sufficiently along the back panel of the backpack so that the terminating end rests against a wearer's body when worn." In rejecting these claims the Examiner states, "The zipper of the Williams device is oriented longitudinally when the backpack is held upright and terminates at the shoulder straps (52) where the end of the zipper would rest against a wearer's body when worn." (May 20, 2005 Final Office Action: p. 2) Williams expressly discloses that "Third zipper 14c originates on front panel 26, travels over top panel 32, and terminates between but just above termination point 38 of zippers 14a and 14b on back panel 28." (Col. 3, ll. 48-51 and Fig. 3a)(emphasis added) The terminating point of zippers 14a and 14b must be above where the shoulder straps 52 are mounted to the backpack 58 to allow shoulder straps 52 to pass fully unobstructed through an opening in fabric enclosure 16 when the zippers are unzipped and flap 42 is rolled back so that the backpack may be worn with the fabric enclosure 16 (see Fig. 4). In order for the terminating end of the zipper 14c to rest against the wearer when worn, as claimed, it would have to be disposed below the position at which the shoulder straps 52 are mounted to the back panel, which is contrary to the express teachings of Williams discussed above (see Figs. 3A, 4 & 5).

Claims 10 and 20 call for the terminating end of the releasable securing device/zipper chain to be disposed on the back panel of the backpack and "extend at least substantially halfway along the back panel of the backpack when the backpack is held substantially upright". The Examiner fails to establish where the reference expressly teaches the claimed limitation as found in claims 10 and 20 instead, merely concluding that it would have been obvious to modify the length of the releasable securing device shown in Figure 8 to extend at least substantially halfway along the back panel. (May 20, 2005 Final Office Action: p.3) Figure 8 of Williams teaches the terminating point of the V arranged zippers disposed on the top panel 32 of the fabric enclosure 16, rather than on the back panel, as expressly called for in base claims 1 and 12 from which claims 10 and 20, respectively, depend. Accordingly, Williams fails to disclose a

backpack in which the releasable securing device/zipper chain has a terminating end disposed on the back panel, a beginning end disposed on a second panel, and that the releasable securing device/zipper chain extends at least substantially halfway along the back panel of the backpack when the backpack is held substantially upright.

Moreover, Williams et al. teaches away from modifying the fabric enclosure 16 so that the terminating end of the zipper disposed on the back panel extends at least substantially halfway down the back panel when the backpack is in an upright position. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP §2143)(citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). The expressed intended purpose of the zippers 14a and 14b are so that when unzipped and the flap is rolled up the shoulder straps 52 of the backpack 58 disposed inside the fabric enclosure 16 may pass therethrough and be worn by the user while the backpack is shielded by the enclosure. (Col. 2, ll. 10-15) Assuming, *arguendo*, that the terminating end of zipper 14c were modified so as to be disposed substantially halfway down the back panel when the backpack is disposed in an upright position, then the terminating ends of the other two zippers 14a, 14b would also have to be proximate to that of zipper 14c to ensure that a common padlock can interconnect the tabs of the zippers. (Col. 2, ll. 1-5) If the terminating ends of the zippers 14a and 14b are disposed substantially halfway down the back panel of the backpack then in an unzipped state the flap would not provide sufficient clearance for the shoulder straps 52 in their entirety to pass unobstructed therethrough and be worn with the fabric enclosure 16 in place, thereby teaching away from the intended purpose of the invention.

For the foregoing reasons, applicant submits claims 1-24 are patentable over the art of record.

Respectfully submitted,

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